

REMARKS

Claims 1-26 are currently pending.

Claims 14-26 are canceled in this amendment. Applicants reserve the right to pursue the subject matter of these canceled claims in a Divisional or Continuation application.

Claim 1 has been amended to recite that the method is for treatment of parasitic disease caused by malaria. In addition, the claim has been amended to specify that in R¹⁰ and R¹¹, the pharmaceutically acceptable ether, ester or amide is formed by reaction with the preceding hydroxyl and/or amino group. Support for this amendment can be found in the Specification on page 13, lines 3-6.

No new matter has been added.

Rejections Under 35 USC § 112, First Paragraph

The Examiner has rejected claims 1-13 for lack of enablement, stating that while the claims are enabled for a method of treatment of malaria, it does not provide reasonable enablement for treatment of all other parasitic infections, nor for a method of prophylaxis of malaria or parasitic infections generally.

Applicants have amended the claims to recite a method of treatment of parasitic infections that cause malaria, thereby overcoming the rejection.

Rejections Under 35 USC § 112, Second Paragraph

The Examiner has rejected claim 1 for use of the phrase "such as," indicating that this phrase makes the claim indefinite and unclear.

Applicants have deleted this phrase, thereby overcoming the rejection.

The Examiner has rejected the claims for recitation of the phrase "or a pharmaceutically acceptable ether, amide or ester thereof," contending that because the definition for R¹⁰ and R¹¹ include terms such as H, F, CH₃, etc. which can not have a corresponding ether, amide, etc., it is unclear what is meant.

Applicants have amended the claims so that they clearly state that the esters, ethers and amides are produced by reaction with the preceding hydroxyl and/or amino group. The skilled artisan would understand that if no hydroxyl or amino group were present, e.g. for CH₃, then no ester, ether or amide would be produced. Consequently, Applicants request reconsideration and removal of the rejection.

The Examiner has rejected claim 16 and states that there is insufficient antecedent basis for claim 16's recitation of "R¹⁰ and R¹¹ define an olefinic bond or a cyclopropyl group."

Applicants have canceled claim 16, thereby obviating the rejection.

The Examiner has rejected claim 17 for lack of antecedent basis for the recitation of "R¹¹ is CH₂OH."

Applicants have canceled claim 17, thereby obviating the rejection.

The Examiner has rejected claim 25 as improper.

Applicants have canceled claim 25, thereby obviating the rejection.

Rejections Under 35 USC § 102

The Examiner has rejected claim 25 as anticipated by Cook et al. (WO 95/18820), Takaku et al. (JP 63060929) and Takaku et al. (JP 63165373). The Examiner's reasoning can be found on pages 7 and 8 of the Office Action.

Applicants have canceled claim 25, thereby obviating the rejection.

Rejections Under 35 USC § 103

The Examiner has rejected claims 14-25 as obvious over Takaku et al. (JP 63165373). The Examiner's reasoning can be found on pages 8-10 of the Office Action.

Applicants have canceled claim 25, thereby obviating the rejection.

Conclusion

In view of the above, all of the claims are submitted as defining non-obvious, patentable subject matter. Reconsideration of the rejections and allowance of the claims are respectfully requested.

The Commissioner is hereby authorized to charge Deposit Account No. 02-2448 in the amount of \$490 under 37 CFR § 1.117(a)(2) for extension for response within the second month.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Susan W. Gorman, Reg. No. 47,604 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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